IV. Judicial Review Of The Question Presented Must Necessarily Analyze The Impact Of The 1999 Amendment

Petitioner argues there is a three-way split of authority among appellate circuits[5] concerning the treatment of willfulness as a prerequisite for an award of profits for violation of Section 43(a). *See*, Petition, p. 10. Petitioner claims that even though the 1999 Amendment "has an explicit requirement of willfulness only with respect to *dilution* claims under Section 43(c)," there are still three circuits that hold that willfulness is an absolute prerequisite for awards for infringement under Section 43(a). *Id.*

Many of the cases cited by Petitioner as illustrating the circuit split pre-date the enactment of the 1999 Amendment. As such, Petitioner has essentially proved that the alleged circuit split existed *before* the enactment of the 1999 Amendment and continues to exist after the enactment of the 1999 Amendment. Petitioner further submits that proper interpretation of the Amendment should put to rest any doubts about whether willfulness is an absolute prerequisite to an award of profits.

Petitioner urges the Court, therefore, to review this case to reconcile the alleged split of authority ***and*** to thus properly construe the 1999 Amendment. Implicit in Petitioner's logic is the requirement that a comprehensive review of the question presented must include an analysis of the 1999 Amendment. It is, after all, not possible to render a thorough review of the willfulness issue without

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[5] Respondent disagrees that there is a significant split of authority, however, whether there is or is not is of no import for whether review is appropriate here.

considering the present state of the law. As such, any review of the question presented, must necessarily consider the effect of the 1999 Amendment as well as the decisions that have commented upon it.[6] Since the Amendment does not affect FPI, this is not the right case for review of the questions presented.

CONCLUSION

For the forgoing reasons, FPI requests that the Court deny review.

Respectfully submitted,

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Dated: August 31, 2005

[6] Respondent has located four cases which rely, at least in part, in analyzing the willfulness element as it relates to monetary remedies per Section 43(a) violations on the 1999 Amendment. These include: *Banjo Buddies, Inc. v. Renovsky*, 379 F.3d 168 (3rd Cir. 2005); *Quick Technologies, Inc. v. Sage Group PLC*, 313 F.3d 338 (5th Cir. 2002); *Gucci America v. Daffy's Inc.*, 354 F.3d 228 (3rd Cir. 2003); *Nike, Inc. v. Top Brand Co., Ltd.*, 2005 WL 1654859 (S.D. N.Y. 2005). A review of the question presented therefore, will necessarily have to analyze these courts' views on the 1999 Amendment.

No. 04-1693

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In The
Supreme Court of the United States

CONTESSA FOOD PRODUCTS, INC.,

Petitioner,

vs.

BERDEX SEAFOOD, INC., et al.,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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CORPORATE DISCLOSURE STATEMENT

Pursuant to Supreme Court Rule 29.6, Slade Gorton & Company, Inc. states that it has no parent corporation and no publicly held corporation holds ten percent (10%) or more of its stock.

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INTRODUCTION

Respondent Slade Gorton & Company, Inc. ("Slade Gorton") hereby opposes Petitioner Contessa Premium Foods, Inc.'s ("Contessa's") Petition for Writ of Certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit in this case. Specifically with regard to Slade Gorton, there is no longer any issue or controversy; thus there is nothing for this Court to review.

The crux of this matter revolves around Contessa's Boiling Shrimp image to which it claims ownership of certain copyrights and trademark rights.

Petitioner Contessa is an importer and distributor of seafood, including shrimp. (See Petition at page 3). Like the other respondents, Slade Gorton is in the business of distributing seafood products, including shrimp. In or about 1988, Contessa began selling shrimp bearing the Boiling Shrimp image on its box packages. [Court of Appeal Excerpts of Record "C.A. ER" 6-153/1444:¶30[1]].

Contessa contends that from approximately 1997 to 1998, Lockpur Fish Processing Co. ("Lockpur") shipped frozen shrimp in "*Sea Star*" brand packaging bearing a photograph similar to the Boiling Shrimp image. (See Petition at page 3). Packages of the Lockpur frozen shrimp product were shipped in generic cartons made of corrugated cardboard. Each carton contained six smaller four-pound packages of shrimp. Lockpur's version of the Boiling Shrimp image appeared only on the inner packages – not

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[1] The Court of Appeals Excerpts of Record by Contessa "C.A. ER" are referenced as follows: [C.A. ER volume #-tab # / page #: line # or paragraph #]

on the outer cartons. (See Petition at page 3 and C.A. ER 3-76/0694:¶4).

Contessa has eloquently described the packaging used by Lockpur which infringed on its Boiling Shrimp image. However, Contessa completely failed to mention that Lockpur also used at least one type of packaging that did *not* display the Boiling Shrimp image – which did not infringe Contessa's purported copyright under the Copyright Act (17 U.S.C. §505). (See App. 5a and fn. 2 attached to Petition).

Contessa contends that the respondents, including Slade Gorton, infringed its copyright by distributing to their own customers the frozen shrimp packed by Lockpur.[2] However, the evidence all along has shown that Slade Gorton did not participate in the packing process and never possessed, sold, and/or distributed shrimp bearing the alleged infringing image.

The District Court and the Court of Appeal correctly decided that Contessa's claims against Slade Gorton were without merit. (See App. 1a-8a in Petitioner's petition). Specifically, the Court of Appeal for the Ninth Circuit ruled that Contessa's claims against Slade Gorton were based solely upon speculation. (See App. 6a in Petitioner's petition). Still without any evidence that Slade Gorton ever possessed (let alone distribute) the infringing packaging, Contessa now seeks review from this Court.

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[2] On page 6 of its Petition, in footnote 5, Contessa concedes that it is not seeking review of the trademark claims against Slade Gorton and other respondents.

STATEMENT OF FACTS PERTINENT TO SLADE GORTON

Petitioner states in its brief on page 3 that "Respondents . . . bought tens of thousands of cartons of frozen shrimp from Lockpur Food Products, Inc." As to Slade Gorton, this statement is incorrect. Slade Gorton never purchased any *Sea Star* shrimp from Lockpur. Rather, the only purchases by Slade Gorton of frozen shrimp that are the subject of this litigation are two isolated purchases – one from Hanwa American Corporation ("Hanwa") in 1998 and the other from Coast-to-Coast ("Coast") in 1999. [Slade Gorton's C.A. ER 1/page 2:¶6; see also Contessa's Court of Appeal Opening Brief at p. 8, fn. 5].

Accordingly, to hold Slade Gorton liable under any theory of copyright infringement, Contessa must first establish that Slade Gorton purchased shrimp in the infringing packaging from either (or both) Hanwa or Coast. Contessa has failed to produce such evidence. In fact, the overwhelming evidence shows that Slade Gorton never possessed any shrimp in the infringing packaging.

The record shows that Lockpur used at least one type of packaging that did *not* display the Boiling Shrimp image, which did not infringe its purported copyright. (See App. 5a and fn. 2 in Petitioner's petition, emphasis added). The evidence shows that Slade Gorton never possessed the alleged infringing packaging. Contessa has never come forward with any evidence as to what type of packaging Slade Gorton possessed. This alone is fatal to Contessa's claims against Slade Gorton. Since Slade Gorton never possessed the alleged infringing product, it could not have distributed it to any third parties. Thus, Slade Gorton

cannot be liable for copyright and/or contributory infringement.

Finally, on Page 6 of its Petition, in footnote 5, Contessa concedes that it is *not* seeking review of the trademark claims against Slade Gorton and other respondents:

> "With respect to five other defendants [including Slade Gorton], the [Ninth Circuit] court held that petitioner's trademark claims failed *because petitioner had not produced sufficient evidence to show that those defendants had ever used the Boiling Shrimp Image in commerce*. App. 6a-7a. *Petitioner* does not seek review of this aspect of the court of appeals' decision and, accordingly, *does not challenge the judgment with respect to those five defendants on the trademark claims.*" (Emphasis added).

Accordingly, as to Slade Gorton, there is no longer any issue or controversy for this Court to review.

REASONS FOR DENYING THE WRIT

Petitioner's writ should be denied for the following reasons:

1. Petitioner contends that Lockpur distributed shrimp to the respondents. The evidence shows that Lockpur used at least two different types of packaging for its shrimp that it distributed to others – only one contained the alleged infringing image. In its opinion, the Ninth Circuit determined that " . . . Lockpur only used the [infringing] Image on *some* of its inner packaging" and referred to Lockpur's use of this image as "*sporadic*". (See App. 5a and fn. 2 in Petitioner's petition, emphasis added).

2. There is absolutely no evidence in the record showing that Slade Gorton ever possessed or sold any shrimp in the infringing packaging. At most, Contessa can only *speculate* that employees of Slade Gorton saw the infringing packaging. As stated by the Court of Appeal in its ruling, "Mere speculation is not sufficient to create a genuine issue of material fact sufficient to defeat summary judgment. *Matushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586-587 (1986)." (See App. 6a in Petitioner's petition).

3. As to Slade Gorton, and other respondents like Hanwa and Mazzetta, this Court's recent decision in *MGM Studios, Inc. v. Grokster Ltd.*, Slip Op. No. 04-480 (2005) has no bearing on the decision by the Court of Appeals. A remand in light of this Court's recent decision in *Grokster* would not change the outcome as to Slade Gorton. The holding articulated by this Court in *Grokster* is that "one who ***distributes*** *a device* with the object of promoting its use to infringe copyright, *as shown by clear expression or other affirmative steps taken to foster infringement*, is liable for the resulting acts of infringement by third parties." (Slip. Op. p. 1 (emphasis added).) Here, the Ninth Circuit found that " . . . *there is no admissible evidence in the record that Slade Gorton . . . ever possessed, let alone distributed, the allegedly infringing packaging* . . . " (See App. 6a in Petitioner's petition, emphasis added).

4. Contessa concedes that it is not seeking review of the trademark claims against Slade Gorton. (See Petition at page 6, fn. 5).

5. A petition for a writ of certiorari will be granted only for compelling reasons. Supreme Court Rule 10. Here,

there are no compelling reasons to grant the petition as to Slade Gorton.

6. Based upon the foregoing, Contessa has failed to create any genuine issue of material fact sufficient to defeat summary judgment as to Slade Gorton and the writ should be denied.

CONCLUSION

Based on the foregoing, the Petition for a Writ of Certiorari as to Slade Gorton should be denied.

Dated: August 22, 2005

Respectfully submitted,

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